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| 09/609,232      | 06/30/2000  | Kia Silverbrook      | NPB003US            | 2830             |

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393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

LE, KHANH H

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/609,232

Applicant(s)

SILVERBROOK ET AL.

Examiner

Khanh H. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **Detailed Action**

1. This Office Action is in response to the original application, the Preliminary Amendments filed (papers), Claims 1- 36 are now pending.

### **Examiner's Note**

2. **The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all references passages as potentially teaching all or part of the claimed inventions.**

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1, 6, 10 , 13, 17, 18, 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 5:** "proportional to the number of their advertisements that are printed" lacks antecedent basis.. No printing of such ads were mentioned before. No payment is mentioned that is linked to such printing of ads. Appropriate correction is required.

Further no prior art can be applied because the scope of claim 5 with " proportional to the number of their advertisements that are printed" is too unclear.

Claim 6. "wherein the publishers gain payment from respective advertisers for the advertisements that are placed" lacks antecedent basis. No placing of such ads anywhere were mentioned before. Further the claim is confusing: Where are ads placed? what does payment to the publishers have to do with the payment to the third party? Appropriate correction is required. Further no prior art can be applied because the scope of claim 6 is too unclear as explained above.

Claim 10. "wherein the account provides payments to the second party" contradicts claim 1 as claim 1 recites the account is to pay the third party, not the second party or any other party, and receives payment from the second party. Appropriate correction is required.

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Claim 13. Same rejection as claim 10. Appropriate correction is required.

Claim 17. "the identifier" is confusing. With respect to claim 1, is it the "identifier of the third party" or the identifier as in the phrase "providing the first printed media with an identifier"? Appropriate correction/clarification is required.

Claims 17-18: The fourth information is not specified. The scope of the claim is substantially unclear. Appropriate correction is required.

Claims 21: unclear who gets paid. second party or third party? If third party based on claim 1, then there is missing step. What has third party done with respect to fifth party to get paid by fifth party?

If second party gets paid then there is lack of antecedent basis. Appropriate correction is required.

Here, it is interpreted that second party gets paid for prior art application.

Claim 24 (dependent on 1): "the second printed media respectively lacks antecedent basis. No such second printed media is recited in claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Intelligent Paper" by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406, herein "Intelligent Paper".**

Intelligent Paper discloses

Claim 1. A system for providing printed information to a user that is obtained from a first server of a first party, the system including:

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a user printer module being provided by a second party for interfacing the user with the first server, the module being responsive to the user requesting first information from the first server for generating a first printed media that displays the first information (see Intelligent Paper p. 392-393: interpreted as the Intelligent Paper is printed by the second party for sale to users);

identifier of a third party for providing the first printed media with an identifier such that designation of the identifier by the **user results in the module communicating** second information to the first server or to a second server of a fourth party ( Intelligent Paper p. 397, last paragraph, third party is the "router")

; and

account for providing payments to the third party and for receiving payments from the second party (Intelligent Paper p. 397, last paragraph," the intelligent paper pages can be sole at a price that covers the cost of storing the page-id -URL relation", i.e. the second party bears the cost of the third party and passes on the cost to the user).

Claim 2. 1 including calculation which is responsive to the module for determining the payments (Intelligent Paper p. 397, last paragraph," the intelligent paper pages can be sole at a price that covers the cost of storing the page-id -URL relation", i.e. the second party bears the cost of the third party and passes on the cost to the user).

Claim 3. 1 including a plurality of modules provided to respective users, wherein the calculation is responsive to the number of first media printed by the modules for determining the payment received from the second party (Intelligent Paper p. 397, last paragraph," the intelligent paper pages can be sole at a price that covers the cost of storing the page-id -URL relation", i.e. the second party bears the cost of the third party and passes on the cost to the user).

As to claims 4-5:

"wherein the calculation is responsive to the number of occurrences of second information being sent to the first server or the second server for determining the payment from the first party or the fourth party respectively wherein the first and the fourth parties are respective on-line publishers "

Intelligent Paper p. 399-401 discloses linking to on-line content providers for more information. It is well-known parties referring potential consumers to commercial websites get rewarded by the websites owners. The Intelligent Paper page id-URL router plays the role of such referring party to the first and fourth parties. Thus it would have been obvious to one skilled in the art at the time of the invention to pay the third party by the first or fourth parties.

Intelligent Paper does not disclose "the payments they make are a fixed amount for a predetermined period" however payment as fixed amounts per fixed periods are common commercial service contract terms used for simplicity thus it would have been obvious to one skilled in the art at the time of the invention to add such feature to the scheme of Intelligent Paper in order to achieve the above mentioned advantage.

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As to claims 7-9, Intelligent Paper at pages 400-401 discloses linked commercial transactions. Payment to the referring party is obvious similarly as explained in claims 4-5.

Claims 10-11: It is interpreted from these claims language, that the second party (the printing party) is paid by the users of the "intelligent paper". It is well-known usable printed papers are sold by the sheet thus it would have been obvious to one skilled in the art at the time of the invention to add this conventional cost feature to the Intelligent Paper scheme to compensate the printing party.

Claims 12-14:

The types of payments/accounts are ordinary types and thus it would have been obvious to one skilled in the art at the time of the invention to add to Intelligent Paper to facilitate accounting among parties.

Claims 15-18: Intelligent Paper discloses at page 404 , 2<sup>nd</sup> full paragraph that a user peripheral used to receive the linked information after pointing on the intelligent paper is a printer. It is obvious a printer printing intelligent paper can be used to further provide more information. Thus it would have been obvious to one skilled in the art at the time of the invention to add such a printer to the Intelligent Paper scheme in order to achieve the above-mentioned advantage.

Claims 19-23: Intelligent Paper discloses as stated above that 2<sup>nd</sup> party pays third party for the number of papers printed and passes on the cost to the user. It is known usable papers carry ads (fifth information) . It is further known the advertiser (fifth party) subsidizes the cost of such usable papers (interpretation: fifth party pays into account to third party). Further the subsidy is known to be proportional to the number of ads printed. Thus it would have been obvious to one skilled in the art at the time of the invention to add all those well known commercial practices to Intelligent Paper in order to achieve their well-known advantages.

Claims 24-29 :

Intelligent Paper at least at pages 392 discloses page id-URL mapping (mapping of identifiers and respective functions with one of the functions being placing order for goods/services). Thus Intelligent Paper discloses claims 24- 29.

Intelligent Paper does not specifically disclose it is the printing module that determines and initiates the function after the user designates the identifier. However Intelligent Paper discloses the combination of a pointer and a peripheral such as a printer ( page 404 , 2<sup>nd</sup> full paragraph ) to initiate the function . Thus it would have been obvious to one skilled in the art at the time of the invention to add the module as initiating the function in order to achieve the above-mentioned advantage.

Claims 30-33:

As to claims 30-31: 1 wherein the module stores in a cache mapping data indicative of at least the information printed on the media most recently generated and the identifier last designated.

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Official Notice is taken that caches, small fast memory holding recently accessed data, designed to speed up subsequent access to the same data are well-known to be used for a local copy of data accessible over a network on the assumption that the processor will probably need that data it again soon. Thus it would have been obvious to one skilled in the art at the time of the invention to add such cache to store at least the information printed on the media most recently generated and the identifier last designated in order to achieve the well-known advantages of caches as discussed above.

Claim 32. 31 wherein the media is a page and the cache is sufficiently large to allow the local storage of mapping data indicative of more than one page.

Intelligent Paper discloses the media is a page. Further a cache is well-known to be large enough to be able to store mapping data indicative of more than one page thus it would have been obvious to one skilled in the art at the time of the invention to add such cache feature in the teachings of Intelligent Paper in order to allow rapid access if the user desires to access the identifiers on more than one page.

Claim 33.

Intelligent Paper, discloses at p. 397, last paragraph, the third party (router) is a persistent storage provider of the mapping data for the printed media generated by the system.

Claims 34-35:

Intelligent Paper, at pages 396 ("technology") discloses wherein the identifier is printed on the respective printed media respective printed media by one of the modules (the printing modules that later sell the paper to users) .

Claim 36 substantially parallels claim 1 and is rejected similarly.

### **Conclusion**

7. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

September 21, 2003

KHL

*Steve Gravini*  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**